

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Suzuki, et al

Confirmation No. 9403

Serial No. 09/241,989

Group Art Unit: 2871

Filed: February 2, 1999

Examiner: Duong, Thoi V.

For: **Optical Film and Liquid Crystal Display
Device Using the Film**

TKHR Ref. 250129-1030

**PETITION TO HAVE REISSUE DECLARATION ACCEPTED
PURSUANT TO 37 CFR 1.181**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant hereby petitions the Director to have accepted the reissue declaration submitted in this application.

Summary

This is a reissue application, which has now been in prosecution before the U.S. PTO for over 10 years. At this stage of the reissue proceedings, all pending claims have been substantively allowed. However, the Examiner states that this reissue

application cannot be allowed, because both an original reissue declaration stands rejected (although it was initially accepted), and a substitute/supplemental declaration has been rejected. In rejecting the declarations, the Examiner states that the error(s) alleged in the declaration(s) are not errors upon which reissue can be granted. This position is clearly false. According to the reissue statute of 35 U.S.C. 251: "Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of ... the patentee claiming more or less than he had a right to claim in the patent, the Director shall ... reissue the patent for the invention ..."

As pending claims in this reissue application are of different scope than the original issued claims (without any deceptive intent), the original patent is rendered either partially or wholly inoperative, making reissue entirely proper.

Consequently, the Examiner's position is clearly erroneous, and the declaration(s) submitted in this reissue application should be accepted.

Statement of Facts and Relevant Discussion

As set forth above, this reissue application was filed over 10 years ago. The original declaration was accepted (or at least was not objected to).

All pending claims (as amended through the reissue prosecution) have now been allowed, and the only outstanding issue is that pertaining to the declaration.

In recent months, during the tail end of this prosecution, the Examiner raised an objection to the declaration. In response, the undersigned commissioned an

investigator to locate the original inventors (because they were formerly employed by IBM in Japan, but are no longer employed there). The inventors were located and executed a substitute/supplemental declaration. After submitting that declaration (and receiving a further, FINAL rejection, the undersigned discussed this matter by telephone with Examiner Duong. During that telephone discussion, the undersigned came to understand that the original declaration was now being rejected, as a result of a supervisory review of this reissue application.

The rejection of the declaration is made on the basis that the declaration is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. In this regard, the Office Action stated that the feature being relied upon (as constituting the “error”) was claimed in the original patent as claims 2, 5, and 7. This position is erroneous.

In this regard, the reissue statute clearly states that: “Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent ...” (35 U.S.C. § 251). If an independent claim would be invalid without a feature of a dependent claim, then the patent would be “partly inoperative or invalid, by reason ... of the patentee claiming more or less than he had a right to claim.” Thus, the error alleged in both the original declaration and in the supplemental/substitute declaration are clearly proper, in view of

the reissue statute. Frankly, the undersigned doesn't even understand the basis upon which these declarations have been refused.

By way of illustration, an annotated version of claim 1 is set forth below:

1. A liquid crystal display device including a liquid crystal display panel and a back light device, said back light device comprising:

a light source for emitting light;

a light guide means having a top surface facing a back surface of said liquid crystal display panel and a side surface receiving said light from said light source;

a reflector means provided on a back surface of said light guide means; and—

an optical film of transparent material positioned between said back surface of said liquid crystal display panel and said top surface of said light guide means, including a first surface having a wave structure including a plurality of regularly spaced isosceles triangle prisms arranged side-by-side, the prisms having smooth surfaces, and a second ~~surfaces~~surfacings having an optically rough structure for performing diffuse transmissions, wherein a top angle of said isosceles triangle prisms is in a range of 95 degrees to 120 degrees for flat, angles ~~prism~~prisms surfaces to gather light from the diffuse transmission into a desired viewing angle for the liquid crystal display panel.—

wherein a polarizer is positioned between said liquid crystal display panel and said optical film, and a direction along which said peaks and valleys of said isosceles triangle prisms are oriented is aligned in parallel to a polarizing axis of said polarizer and the tops of the isosceles triangle prisms are not farther than 160 μm apart.

Underlining in the above annotates features that were added to claim 1 during the prosecution of the reissue application. That is, claim 1 (above) is annotated with respect to the original issued patent. It is, therefore, clear that claim 1 (in its presently pending form) is narrower than the original issued claim 1.

The Examiner's stated position that the error is not one upon which reissue can be granted is inconsistent with the positions taken by the examiner during prosecution (which led to a narrowing of the claim). Stated another way, if the declaration is not

accepted and this reissue application is terminated, then the original issued patent remains in force. Maintaining the rejection of the declaration (by the PTO) is therefore a tacit allegation that the original issued patent is neither wholly nor partially invalid or inoperative, and claim 1 (as issued) patentably defines over the prior art.

In addition, the FINAL Office Action stated “Further, the reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected ... arose without any deceptive intention on the part of the applicant.” (Final Office Action, p. 2, bottom paragraph). This statement is clearly incorrect. First, the supplemental declaration submitted on April 28, 2003 contained this statement. In this regard, the second to last page of that declaration states “All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.” The declaration that was more recently filed by the undersigned, on August 26, 2008, clearly includes this statement (as the declaration was provided in the form of FORM PTO/SB/51, and this language is included as part of the form itself – see top of page 2 of that declaration).

With the foregoing explanations, the undersigned respectfully submits that the rejections of both the original declaration and the declaration submitted in August 2008 are both misplaced. It should be appreciated that, only one of these declarations needs to be accepted to place the application in condition for allowance.

As set forth above, the basis of the declaration clearly comports with the relevant reissue statute, as it cites an error which renders the original patent partially invalid or

inoperative. Therefore, the rejections that the declarations fail to recite an error upon which reissue can be based are clearly misplaced.

Propriety of this Petition

After the mailing of the FINAL Office Action, Applicant responded and requested the Examiner to reconsider his decision to reject the declaration(s). An Advisory Action was mailed April 17, 2009, and this petition is filed within two months of the mailing date of the Advisory Action (pursuant to 37 CFR 1.181(f)).

No separate Affidavits or Exhibits are attached to this petition, as no supplemental or external evidence is being relied upon. As set forth above in the statement of relevant facts, all facts relevant for the determination of this petition (i.e., the existence and content of the declarations submitted in this reissue application file) have already been made of record.

No fee is believed to be due in connection with this petition. If, however, any fee is believed to be due for the consideration of this petition, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

/Daniel R. McClure/

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